



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,054	01/14/2002	Pekka Koivukunnas	33047/242570	3510

826 7590 03/13/2003

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

HASTINGS, KAREN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 03/13/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047054

Applicant(s)

Koivukunnas et al

Examiner

HASTINGS

Group Art Unit

1731

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

Art Unit 1731

Claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The claims are unclear and indefinite in that it is not clear that the arrangement is in a paper machine and the recitations relating the surface extending over the whole width of the paper web are merely intended use without positively claiming in a paper machine. It is suggested that claim 1 line 1 --in a paper machine-- be inserted after "an arrangement".

Furthermore, the specification at page 3 second paragraph in describing the essential idea of the invention defines the support surface as ~~unmoving~~. This should be reflected in the claims; that is, on line 4 of claim 1 change "a" to --an unmoving-- in order to be clear and commensurate in scope with the specification.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit 1731

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-6, 9, 11 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hujer et al. or Lucas et al.

Each of Hujer et al. and Lucas et al. teaches a sensor/measuring means for a paper web with a curved plane-like

Art Unit 1731

support surface for supporting the paper web, with the measuring means arranged to measure properties through an opening in the support surface. See Fig 1-3, abstract and col 3 line 58 to col 4 line 30 of Hujer; Fig 1 and abstract of Lucas.

Since claim 1 is not positively claimed in combination with a paper machine, the recitation that the support surface extends over the whole width of the paper web is merely intended use. Further either of Lucas or Hujer et al. could extend, that is, are capable of extending, over the whole width of a paper web/strip in use.

But again, the examiner's position is that the width of the paper web is not a material apparatus limitation in the claims as now worded.

Any differences that may be gleaned over the present claim language are deemed to be *prima facie* obvious modifications.

Claims 1, 2, 9 and 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hultcrantz et al.

Hultcrantz et al. teaches a support strip with at least one through opening to expose the paper web to a measurement means etc. Hultcrantz et al.'s support strip is a continuous flexible strip that extends across the entire width of the paper web. The

Art Unit 1731

support strip may be wound and unwound for displacement. See e.g. abstract and Figure 3.

However the claims as worded do not define over this reference since a ~~the~~plane-like support surface~~as~~ as claimed reads on a continuous tensioned flexible support strip as taught in Hultcrantz. Note for example the claims do NOT specify that the plane-like support surface is unmoving in order to distinguish over this reference.

Any differences that may be gleaned over the present claim language are deemed to be *prima facie* obvious modifications.

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hujer et al. or Lucas et al. or Hultcrantz et al.

These references are applied as above. In addition the dependent claims not addressed above merely define known technical features and options for measuring to one of ordinary skill in the art and as such would have been prima facie obvious modifications of these references.

At least claims 1, 2, 5, 8, 9 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Breyer.

Breyer teaches a support with at least one through opening to expose a traveling web to a measurement means etc. (E.g.,

Art Unit 1731

measurement tubes 10). Breyer's measurement device/support extends across the entire width of the web. See Figure 1,3,4. Breyer is measuring an impermeable web as opposed to a paper web. However, the claims do not structurally distinguish thereover since as worded the use of the arrangement on a paper web is merely an intended use without positively claiming that the arrangement is in a paper machine.

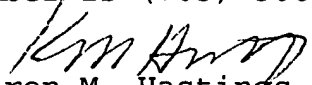
Indication of Allowable Subject Matter:

If applicants amended claim 1 to clearly define that the arrangement is --in a paper making machine-- and that the plane-like support surface is -- unmovng-- and extending across the whole width of the paper web in the machine, as set forth in their specification, then such a claim would be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hastings whose telephone number is (703) 308-0470. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on (703) 308-1164. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.


Karen M. Hastings
Senior Primary Examiner
Art Unit 1731

KMH/cdc
March 6, 2003

3/03